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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/709,402

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Ronald H. Naismith

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LEGAL DEPT. - I.P. GROUP

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EXAMINER

NGUYEN, DUSTIN

ART UNIT

PAPER NUMBER

2154

MAIL DATE

DELIVERY MODE

03/17/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/709,402

Applicant(s)

NAISMITH ET AL.

Examiner

DUSTIN NGUYEN

Art Unit

2154

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 December 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SE/US)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. Claims 1-18 are presented for examination.

Response to Arguments

2. Applicant's arguments filed 12/21/2007 have been fully considered but they are not persuasive.
3. As per remarks, Applicants' argued that (1) Nakatani fails to disclose the claimed feature of "searching for an address configuration server by said first automation device".
4. As to point (1), as mentioned in previous Office Action, Nakatani discloses a system and method of utilizing a network protocol dynamically to address and to configure a remote device implemented in a monitor and control system [Abstract; and paragraph 0001]. The system of Nakatani teaches that a newly connected device, or Industrial Automation Device (IAD), may be configured to transmit or to broadcast a request for assignment of a dynamic network address across network to a AMS, and upon receipt of such a broadcast signal, AMS may identify the IAD, assign IAD a dynamic network address and apprise IAD of the assigned address [i.e. broadly interpreted as searching for an address configuration server by said first automation device as claimed] [paragraphs 0017, 0051 and 0058].

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5. As per remarks, Applicants' argued that (2) Nakatani fails to disclose the claimed feature of "using automation specific protocol".

6. As to point (2), Applicant's disclosure gives examples of an automation specific protocol such as MODBUS, MODBUS/TCP, Devicenet, Profinet, CANOpen, Ethernet/IP, FieldBus Foundation or other protocol designed specifically for use in automation. In this case and in the same field of endeavor, Nakatani discloses a system and method for assigning both network address information as well as operational parameters according to a dynamic protocol for industrial automation devices, wherein the network connections and protocols include TCP/IP, Ethernet, FDDI, ARCNET, token bus, USB, and FireWire [i.e. TCP, IP, Ethernet, or other protocol] [paragraphs 0010, 0032, and 0033].

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1, 2, 4-9, 11-15, 17 and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Nakatani [US Patent Application No 2003/0061384].

9. As per claim 1, Nakatani discloses the invention as claimed including a method of automatically configuring a first automation device connected to a network system using an automation specific protocol [i.e. a system and method of addressing and configuring a remote device implemented a dynamic device addressing and configuration protocol] [Abstract; and paragraphs 0001 and 0010], the steps comprising:

searching for an address of a configuration server by said first automation device [i.e. the IAD broadcast a request for assignment of a dynamic network address] [paragraphs 0017, 0051 and 0058];

searching a memory of the configuration server for a configuration designated for said first automation device [i.e. identify IAD and assign both network address information as well as operational parameters] [Figure 6; Abstract; paragraphs 0051-0054 and 0057-0061]; and

loading said configuration from the configuration server into said first automation device using the automation specific protocol [i.e. operational parameter assigner may be configured to transmit] [paragraphs 0054 and 0061].

10. As per claim 2, Nakatani discloses wherein the automation specific protocol is MODBUS/TCP [paragraph 0032].

11. As per claim 4, Nakatani discloses wherein the first automation device is a programmable logic controller [paragraphs 0034-0036].

12. As per claim 5, Nakatani discloses wherein the first automation device is an IO module [paragraphs 0022 and 0028].
13. As per claim 6, Nakatani discloses scanning a bar code identifier of the first automation device [i.e. identify the failed IAD] [711, Figure 7; and paragraphs 0020 and 0064]; scanning a bar code identifier for a second automation device [i.e. identify replacement IAD] [712, Figure 7; and paragraphs 0063 and 0064]; and replacing the bar code identifier for the first automation device in the memory of the configuration in the configuration server with the bar code identifier of the second automation device [i.e. assign network address and operational parameter] [713-715, Figure 6; and paragraphs 0065-0067].
14. As per claim 7, Nakatani discloses wherein the search of the memory of the configuration server is performed by the configuration server [Figure 5; and paragraphs 0049 and 0050].
15. As per claim 8, Nakatani discloses the invention as claimed including a factory automation system for the automatic configuration of automation devices [i.e. a system and method of addressing and configuring a remote device implemented a dynamic device addressing and configuration protocol] [Abstract; and paragraphs 0001 and 0010], the system comprising:
- a network utilizing an automation specific protocol [Figure 1; and paragraphs 0012 and 0013];

a configuration server connected to the network [Figure 5; and paragraphs 0017 and 0050], containing at least one configuration for the automation devices [i.e. operational parameter] [paragraphs 0054 and 0055], wherein said at least one configuration is available to said automation devices [paragraphs 0073 and 0074]; and

the automation devices connected to the network, capable of searching for the configuration server on the network utilizing the automation specific protocol [i.e. the IAD broadcast a request for assignment of a dynamic network address] [paragraphs 0017, 0051 and 0058], finding a specific configuration within said configuration server [i.e. identify IAD and assign both network address information as well as operational parameters] [Figure 6; Abstract; paragraphs 0051-0054 and 0057-0061], and loading the specific configuration [i.e. operational parameter assigner may be configured to transmit] [paragraphs 0054 and 0061].

16. As per claims 9, 11 and 12, they are rejected for similar reasons as stated above in claims 2, 4 and 5.

17. As per claim 13, it is rejected for similar reasons as stated above in claims 6 and 8.

18. As per claims 14, 15, 17 and 18, they are rejected for similar reasons as stated above in claims 8, 9, 11 and 12.

19. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

20. Claims 3, 10 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nakatani [US Patent Application No 2003/0061384], in view of Vasko et al. [US Patent No 7,058,712].

21. As per claim 3, Nakatani does not specifically disclose wherein the automation specific protocol is MODBUS. Vasko discloses wherein the automation specific protocol is MODBUS [col 1, lines 50-55; and col 12, lines 38-44]. It would have been obvious to a person skill in the art at the time the invention was made to combine the teaching of Nakatani and Vasko because the teaching of MODBUS in Vasko would allow to control multiple applications ranging from complex and highly distributed to more traditional and repetitious application [Vasko, col 1, lines 55-59].

22. As per claims 10 and 16, they are rejected for similar reasons as stated above in claim 3.

23. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dustin Nguyen whose telephone number is (571) 272-3971. The examiner can normally be reached on flex.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan Flynn can be reached at (571) 272-1915. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Dustin Nguyen/
Primary Examiner, Art Unit 2154